REMARKS

In the Office Action[1] mailed January 9, 2008, the Examiner rejected claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite; objected to claims 4 and 23 for informalities; rejected claims 1-3, 7-13, 15-22, 26-32, and 34-39[2] under 35 U.S.C. § 102(e) as being anticipated by *Todd* (U.S. Patent Application Publication 2003/0061093); rejected claims 4-6, and 23-25 under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view of *Atkins* (U.S. Patent No. 5,644,727); and rejected claim 14 and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Todd* in view Examiner's Official Notice.

Applicant amends claims 4, 21, and 23. Thus, claims 1-39 are pending and under current examination.

The rejection of claim 3 under 35 U.S.C. § 112

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The MPEP explains that "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure[.]" *See* MPEP §2173 at § 2173.02 ("Clarity and Precision"). "If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." *S3, Inc.*

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1 The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

2 In Item 7 on Page 3, line 1 of the Office Action, the listing of claims does not correspond to all claims addressed under Item 7. Applicant understands this to be a clerical error and treats the listing of claims on Page 3, line 1 to correspond to all claims addressed in Item 7.

v. Nvida Corp., 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001), quoting *Miles Laboratories, Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Claim 3 meets these requirements.

Applicant submits that claim 3 is not indefinite because it clearly recites "configuring the first financial account based on input received from the user." In one exemplary embodiment, Applicant's specification states, "[c]onfiguring the account may include setting up a new financial account for user 135 or reconfiguring an existing financial account managed by financial account provider 110-1." See specification page 12, lines 12-14. Accordingly, because claim 3 is not indefinite, Applicant requests that the Examiner withdraw the rejection of this claim under 35 U.S.C. § 112, second paragraph.

The objection to claims 4 and 23

The Examiner objected to claims 4 and 23 for informalities. In accordance with the Examiner's suggestions, Applicant amends claims 4 and 23 to correct grammatical errors. Applicant therefore requests that the Examiner withdraw the objection to claims 4 and 23.

The rejection of claims under 35 U.S.C. § 102(e)

Applicant respectfully traverse the rejection of claims 1-3, 7-13, 15-22, 26-32, and 34-39 under 35 U.S.C. § 102(e) as anticipated by *Todd*. In order to properly establish that *Todd* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly

described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Todd does not disclose each and every element of Applicant's claimed invention. For example, *Todd* does not teach or suggest "monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period[,]" (emphasis added) as recited in claim 1, and similarly recited in claims 21, 38, and 39. Instead, *Todd* teaches a system that rewards users of financial services based on transactions completed through a financial services provider in which "the direct advantage to the provider lies in eliminating the need to set up and administer multiple individual investment accounts" (paragraph 28). Therefore, because *Todd* teaches away from multiple accounts, *Todd* fails to teach or suggest "monitoring transactions performed using the first and second financial accounts" (emphasis added, claim 1).

The Examiner cites to paragraphs 45 and 73 in *Todd* to teach "monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period[,]" (emphasis added) as recited in claim 1. However, paragraph 45 is silent with respect to the system monitoring "first and second financial accounts" held by a single user, while paragraph 73 teaches that in calculating the reward amount, "further information preferably is taken into account [including] the transaction location and transaction type[,]" all of which reflect information obtained from the same financial account. Therefore, *Todd* fails to disclose "monitoring transactions performed using the first and second financial accounts over a predetermined

transaction monitoring period[,]" (emphasis added) as recited in claim 1, and similarly recited in claims 21, 38, and 39.

Accordingly, *Todd* fails to anticipate Applicant's independent claim 1 and independent claims 21, 38, and 39 that recite similar recitation above in connection with claim 1. As a result, the rejection of claims 1, 21, 38, and 39 should be withdrawn and the claims allowed.

Dependent claims 2-3, 7-13 and 15-20, and 22, 26-32, and 34-37 are also allowable at least by virtue of their respective dependence from allowable independent claims 1 and 21. Thus, Applicant requests that the rejection of dependent claims 2-3, 7-13,15-20, 22, 26-32, and 34-37 under 35 U.S.C. § 102(e) be withdrawn, and the claims allowed.

The rejection of claims under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 4-6, and 23-25 as being unpatentable over *Todd* in view of *Atkins*. A *prima facie* case of obviousness has not been established because the Examiner has not properly presented evidence that supports the suggestion that the applied references render the claims obvious.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007).* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145.* Furthermore, "[t]he

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III)*, internal citation omitted. In addition, when "determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

Claims 4-6 and 23-25 respectively depend from independent claims 1 and 21, and, accordingly, incorporate each and every element recited in claims 1 and 21. As discussed above, *Todd* fails to teach or suggest the elements recited in claims 1 and 21 and required by claims 4-6, and 23-25. *Atkins* fails to cure the deficiencies of *Todd*. For example, *Atkins* does not teach or suggest "monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period[,]" (emphasis added) as required by claims 4-6, and 23-25.

Therefore, the Examiner has not established a *prima facie* case of the obviousness in rejecting claims 4-6, and 23-25 in view of *Todd* and *Atkins*. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 4-6, and 23-25 and allow the claims.

Applicant further traverses the rejection of claims 14 and 33 as being unpatentable over *Todd* in view of the Examiner's Official Notice. Claims 14 and 33 respectively depend from independent claims 1 and 21, and, accordingly, incorporate each and every element recited in claims 1 and 21. As discussed above, *Todd* fails to

teach or suggest the elements recited in claims 1 and 21 and required by claims 14 and 33. The Examiner's Official Notice fails to cure the deficiencies of *Todd*. For instance, the Examiner's Official Notice does not teach or suggest "monitoring transactions performed using the first and second financial accounts over a predetermined transaction monitoring period[,]" (emphasis added) as required by claims 14 and 33.

Further, Applicant traverses the Examiner's Official Notice because the Notice does not teach that which the Examiner admits is missing from *Todd*. Instead, the Examiner relies on an unsupported Notice to allege that it was well known for "consumers" to "approve any financial transaction before it takes place." Yet, this position does not demonstrate "the user giv[ing] authorization to the first financial account provider to transfer the second financial account transactions to the first financial account[,]" as recited in claims 14 and 33 and missing from *Todd*. This is improper.

Therefore, a *prima facie* case of the obviousness of claims 14 and 33 has not been established over *Todd* and the Examiner's Official Notice. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 14 and 33 and allow the claims.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of pending claims 1-39.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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